



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/765,511

01/27/2004

Edward Snow Willis II

555255012694

2513

43563

7590

11/14/2008

MOFFAT & CO

427 LAURIER AVEUE W., SUITE 1200

OTTAWA, ON K1R 7Y2

CANADA

EXAMINER

BROPHY, MATTHEW J

ART UNIT

PAPER NUMBER

2191

MAIL DATE

DELIVERY MODE

11/14/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/765,511	<b>Applicant(s)</b> WILLIS, EDWARD SNOW	
	<b>Examiner</b> MATTHEW J. BROPHY	<b>Art Unit</b> 2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This office action is in response to amendment filed August 12, 2008
2. Claims 1-10, 12 and 13 are now pending.
3. The text of the rejections maintained in this office action can be found in the previous office action.

### ***Response to Amendment***

#### ***Specification***

The amendment filed 12/6/2007 is entered.

#### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2191

5. Claim 1-10, 12 and 13 rejected on the ground of nonstatutory double patenting over claim\*\*\* of U. S. Patent No. 7,222,340 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter.

The text of these rejections not found in this office action can be found in a previous office action. (Dated July 2, 2007).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

#### ***Claim Rejections - 35 USC § 112***

6. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

#### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2191

7. Claims 1, 3-10 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by US PG Publication 2003/0221189 Birum et al.

8. The text of the rejections maintained in this office action can be found in the previous office action.

9. In addition, with regards to the newly added “avoiding non-volatile memory items creating under other non-volatile memory management schemes.” Examiner maintains that this limitation is anticipated by the

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 2 and 13 rejected under 35 U.S.C. 103 (a) as being unpatentable over US PG Pub 2003/0221189 Birum et al in view of US PG Pub 2002/0078142 Moore ET al.

As described in the previous office action, Birum teaches the limitations of claims 1 and 12, and Moore further teaches the limitations of Claims 2 and 13 (see e.g. Fig 6a as described in the previous office action). In addition, it would be obvious to one of ordinary skill in the art to apply the system versions numbers in Moore to the Birum invention as the two references are in the same field of endeavor, and the use of version numbers provides a tool of comparing operating system products. (Moore Paragraph [0008] “The information may be organized into records that identify things

Art Unit: 2191

such as whether an online driver exists for the device, and if so, **what its version number is, so that other detected versions of that driver (e.g., on a local hard drive) can be compared** against the online version to determine which is the most-recent version and/or the "best match.") further, the well-known comparison of version numbers suggested in Moore would be obvious to try, with both a predictable result (a successful comparison mechanism) and a reasonable expectation of success.

### ***Response to Arguments***

12. Applicant's arguments filed August 12, 2008 have been fully considered but they are not persuasive.

In Remarks, Applicant argues:

A1 Applicant notes that the Examiner has not entered previously submitted amendments to, as, in the Examiner's view, the amendment to the Specification constitutes a new matter. Applicant respectfully submits that the amendments to the Specification were presented based on, and attempt to adopt, Examiner's suggestions. Remark K of Applicant's Sept. 28, 2007 submission states that amendments to consistency paragraphs [0007], [0008], and [0009] mirror amendments to the independent claims 1, 10a and 10b. Amendments to paragraph [0007] concern only amendments to independent claim 1 currently on file. Amendments to paragraph [0008] concern only proposed amendments to independent claim 10a. Remark D and Argument E of Applicant's Sept. 28, 2007 submission propose amending independent claim 10a, in compliance with Examiner's invitation, along non-objectionable wording of

Art Unit: 2191

claim 7 currently on file. Amendments to paragraph [0009] concern only amendments to independent claim 10b, amendments which were undertaken to correct clerical errors, comply with the Examiner's invitation to correct, and to put the claims in better condition for allowance as stated in Remarks G and H of Applicant's submission of Sept. 28, 2007. Applicant notes that the Examiner did not object to the proposed claim amendments. MPEP §714.13 II at first paragraph reads "... The refusal to enter the proposed amendment should not be arbitrary. The proposed amendment should be given sufficient consideration ... if the proposed amendment raises the issue of new matter, the examiner should identify the subject matter that would constitute new matter. If the proposed amendment presents new issues requiring further consideration and/or search, the examiner should provide an explanation as to the reasons why the proposed amendment raises new issues that would require further consideration and/or search. The reasons for non-entry should be concisely expressed." Applicant respectfully notes that the requisite reasons for non-entry of the amendments is absent from the Advisory Action. Therefore Applicant respectfully requests entry of the amendments.

Examiner's Response:

These amendments, not previously entered because the case was under final rejection, have been entered, this argument is now moot.

Art Unit: 2191

In Remarks, Applicant Argues:

A2 Applicant notes that the Examiner has stated that the proposed claim amendments require further consideration, while at the same time the Examiner positively and with certitude states that the "claim limitations are not in condition for allowance" following the cursory review. Applicant respectfully submits, based on the Examiner's own submission, that the Examiner failed to provide support for the stated conclusion with respect to the condition of the claims.

Examiner's Response:

As of the Advisory again, **again the case was under final rejection**. These proposed claim amendments, not considered after a final rejection on the merits, may now, and are considered.

These amendments were not entered previously as the examiner reminds applicant of §714.13 of the MPEP:

"It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims.

Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(b)(3) is expected in all amendments after final rejection."



Art Unit: 2191

In Remarks Applicant Argues:

A3 In the Applicant's Sept. 28, 2007 submission Arguments A to D concern Examiner's previous double patenting objections. Applicant thanks the Examiner for clarifying that the provisional rejection is not applicable. Applicant respectfully suggests that it would be improper for the USPTO to requisition a terminal disclosure in order to rectify patent term adjustment differences which stem from delays incurred at the USPTO. In view of the facts: - that a terminal disclaimer would be irrevocable; - that the Applicant's Sept. 28, 2007 submission has only had a cursory review; and - that the Examiner did not provide a reply to Applicant's Argument C presented in the Sept. 28, 2007 submission, without prejudice and with full intent to advance prosecution, Applicant respectfully proposes reconsidering Examiner's terminal disclaimer requisition after Examiner's reply to Applicant's Argument C presented in the Sept. 28, 2007 submission will be considered.

Examiner's Response:

Examiner respectfully disagrees. Applicants submission of September 28, 2007 was AFTER FINAL REJECTION. In addition, the previous examiner clearly responded to the argument in the Advisory Action, while the clear line of reasoning to support the rejection can be found in the July 2, 2007 final rejection.

In Remarks, Applicant Argues:

Art Unit: 2191

A4 Claims 1, 3 to 10a and 10b stand rejected under 35 U.S.C. §102(e). The requirements of 35 U.S.C. §102(e) are strict. In *W. L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983) the Federal Circuit stated that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." It is not enough for a prior art reference to disclose claimed elements in isolation. Rather, as stated by the Federal Circuit in *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481,485 (Fed. Cir. 1984), "[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.", and further indicated in the same decision that "[i]n deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in the light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference. The Examination Guidelines of the USPTO adopt the above. Before articulating a rejection, the Examiner must first obtain a thorough understanding of the invention disclosed and claimed in the application by reading the specification to understand what has been invented. See MPEP §904 (8th Ed., Rev. 5, Aug. 2006 unchanged by amendments of Oct. 2007). In articulating the rejection, the onus rests with the Examiner to particularly point out how the Examiner construed the prior art to arrive at the articulated rejection. Arguments K to Q point out failures to establish a prima facie case of anticipation in view of the above. Applicant respectfully submits that the Examiner's cursory review fails to take into consideration the above. In particular, giving claim language the

Art Unit: 2191

broadest interpretation is not done in a vacuum but rather in the context of the specification. In *Scripps Clinic & Research Found. V. Genentech Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991), the Federal Circuit stated that the anticipation determination must be viewed from one of ordinary skill in the art: "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." Applicant respectfully proposes, with reference to Argument O submitted Sept. 28, 2007 amending all references to a "carrier" to read --carrier telecommunications company--.

Examiner's Response:

13. Examiner Respectfully Disagrees. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "carrier") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

14. In addition, Applicant again fails to recognize that the Advisory Action was issued under final rejection. The Advisory Action augments the previous final rejection, which included clear delineation of the application of the prior art to the claims of the present application.

A5 Applicant notes that all pending claims 2 and 11 have been rejected under 35 U.S.C. §103(a) as stated at point 15 of the outstanding final Office Action. The outstanding Final Office Action has been issued following the United States Supreme Court's decision in *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350 (April 30, 2007). In light of the KSR decision, Applicant wishes to address various issues pertaining to a proper analysis under section 103. Applicant notes the statement of the Graham factual inquiries presented by the Examiner at point 14 of the outstanding final Office Action. Applicant further respectfully submits that, even after KSR, the following legal principles are still valid, having been endorsed by the Supreme Court or having been unaffected by the KSR decision: (1) the USPTO still has the burden of proof on the issue of obviousness; (2) the USPTO must base its decision upon objective evidence, and it must support its decision with articulated reasoning (slip op. at 14); (3) merely demonstrating that all elements of the claimed invention exist in the prior art is not sufficient to support a determination of obviousness (slip op. at 14-15); (4) hindsight has no place in an obviousness analysis (slip op. at 17); and (5) Applicant is entitled to a careful, thorough, professional examination of the claims (slip op. at 7, 23, in which the Supreme Court remarked that a poor examination reflected poorly upon the USPTO). The Examiner, by citing references and asserting a reason for combining elements from the references, has elected to base the rejection upon a teaching, suggestion or motivation to select and combine features from the cited references. Applicant wishes to point out that the Supreme Court's KSR decision did not reject use of a "teaching,

Art Unit: 2191

suggestion or motivation" analysis as part of an obviousness analysis, characterizing the analysis as "a helpful insight." KSR slip op. at 14-15. When the Examiner chooses to base a rejection upon a teaching, suggestion or motivation analysis, the Examiner must satisfy the requirements of such an analysis. In particular, the Examiner must demonstrate with objective evidence of record and articulate a reasoned argument that there was a teaching, suggestion or motivation to select and combine features from the cited references. E.g., *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Moreover, objective evidence found in the prior art must suggest the desirability of the combination, not merely the feasibility. *In re Fulton*, 73 USPQ2d 1141, 1145 (Fed. Cir. 2004). In order to establish a prima facie case of obviousness, irrespective of the rationale proposed by the Examiner in rejecting a claim, the Examiner must produce objective evidence of record from the prior art showing a reasonable expectation of success from such combination. (see MPEP2143.02) *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986), and *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989).

A6 Arguments G to I in Applicant's Sept. 28, 2007 submission point out deficiencies of the Examiner's final rejection including: failure to produce objective evidence of record of the desirability of the combination, failure to show based on objective evidence of record a reasonable expectation of success in combining the references cited, and the inappropriate use of subjective belief. Respectfully, Examiner's comments in the Advisory Action are not supported by objective evidence of record and prefacing statements in an articulated rejection with "One would expect ..." qualifies the statement

Art Unit: 2191

as a subjective one. MPEP §2144.03 Summary reads "Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421." Argument G of the Applicant's Sept. 28, 2007 submission demonstrates the undesirability of the combination of the prior art references cited particularly as one of the references cited teaches away. Applicant notes that the Examiner did not rebut the Applicant's finding that one of the cited references teaches away. Merely stating that something "provides a predictable result" without more, is insufficient to comply with the required showing based on objective evidence of record a reasonable expectation of success in combining the references cited. In *re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1988).

#### Examiner's Response:

15. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

Art Unit: 2191

where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as described above, the Moore reference explicitly suggests that the operating system version numbers would be useful in matching versions.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In addition, the balance of this argument is moot as the motivation to combine these references has been clarified further above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. BROPHY whose telephone number is 571-270-1642. The examiner can normally be reached on Monday-Thursday 8:00AM-5:00 PM EST.

Art Unit: 2191

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Zhen can be reached on (571) 272-3708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJB

11/06/2008

/Wei Y Zhen/  
Supervisory Patent Examiner, Art Unit 2191